



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,494	01/30/2004	Achim Melching	87333.3321	5036

7590 11/06/2007
BAKER & HOSTETLER LLP
Suite 1100
Washington Square
1050 Connecticut Avenue, N.W.
Washington, DC 20036

EXAMINER

RAMDHANIE, BOBBY

ART UNIT	PAPER NUMBER
----------	--------------

1797

MAIL DATE	DELIVERY MODE
-----------	---------------

11/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,494

Applicant(s)

MELCHING ET AL.

Examiner

Bobby Ramdhanie, Ph.D.

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/30/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/29/2004, 08/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 6, 7, & 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Malin (WO02/059251; An English translation of this reference can be found in US2004/0115101 and rejections listed in this office action are referenced to the English translation). Regarding Claim 1, Malin teaches a climatic cabinet (Figure 1a; [0049]), with a door ([0046]), a utilization space ([0045]), at least one specimen storage device ([0003]), at least one inner transport device ([0053]), and at least one transfer opening ([0046]), characterized in that a buffer specimen storage device ([0081]), and an outer transport device ([0083]) are arranged outside the transfer opening and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device.

2. For Claim 2, Malin teaches the climatic cabinet according to Claim 1, characterized in that the buffer specimen storage device comprises a plurality of specimen storage locations ([0083]). Examiner takes the position that an automatic conveyor system implies a plurality of specimen storage locations.

3. For Claim 3, Malin teaches the buffer specimen device for use with a climatic cabinet in accordance with Claim 1, characterized in that it is designed as a separate unit that can be detachably connected via a coupling device to the climatic cabinet (Figure 5a, item number 151).

4. For Claim 4, Malin teaches the climatic cabinet according to Claim 2, characterized in that the buffer specimen storage device comprises at least one specimen slide cassette (Figure 2d).

5. For Claim 6, Main teaches the climatic cabinet according to Claim 1, characterized in that the outer transport device comprises a vertically movable lift and a horizontally moveable shifting lift (Figure 4a & [0072]).

6. For Claim 7, Malin teaches the climatic cabinet according to Claim 1, characterized in that the transfer location for a specimen is located between the outer and the inner transport device in the area of the transfer opening ([Figure 4b; [0072]).

7. For Claim 11, Malin teaches the subject matter according to Claim 1, characterized in that a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device ([0089]). Examiner takes the position that the air from the device for pre-air-conditioning can travel through the couplings and into the buffer specimen storage device.

8. For Claim 12, Malin teaches the subject matter according to Claim 11, characterized in that the device for pre-air-conditioning is designed as a blower ([0089]).

9. For Claim 13, Malin teaches the subject matter according to Claim 11, characterized in that the device for pre-air-conditioning is controlled as a function of an

actuation of the service opening (Figures 4b & 6b). Examiner takes the position that this is an intended use claim. The patentability of the claim depends on the structural limitations of the claim and not the intended use for the components.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2, 5, 8, 9, & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milan in view of Helwig et al (US6129428). Regarding Claim 2, Milan teaches all of the Claim limitations according to Claim 1. Milan does not explicitly describe that the buffer specimen storage device comprises a plurality of specimen storage locations. Helwig et al teaches this feature (Figure 3a in view of Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan with Helwig et al because according to Helwig et al, this would

Art Unit: 1797

limit the large amount of climatic fluctuations experienced in the use of climatic cabinets (Column 3 lines 7-18).

13. For Claim 5, Milan teaches the climatic cabinet according to Claim 3. Milan does not teach that the buffer specimen storage device comprises several specimen storage cassettes in a carousel arrangement. Helwig et al teaches this feature (Figure 3a). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan with Helwig et al because this would limit the large amount of climatic fluctuations experienced in the use of other climatic cabinets (Column 3 lines 7-18).

14. For Claim 8, Milan teaches all of the of claim limitations according to Claim 1. Milan further teaches several transfer openings (Figure 2.; Examiner takes the position that the front door and the auxiliary door can both be considered transfer openings). Milan does not teach that there are several transfer openings by which correspondingly many specimen storage devices are loaded by several inner transport devices, characterized in that the outer transport device has an operative connection to all transfer openings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milan to have several transfer openings by which correspondingly many specimen storage devices are loaded by several inner transport devices, characterized in that the outer transport device has an operative connection to all transfer openings because this would increase efficiency and the limitation of Helwig et al which states that the two carousels are not for short term intervals. Examiner takes the position that if the carousels were used for short term intervals, the temperature of

Art Unit: 1797

the cabinet would rise and would be harder to maintain. The use of multiple transfer openings, inner and outer transfer devices, and multiple carousels would be obvious to compensate for the limitations described by Helwig et al.

15. For Claim 9, Milan in combination with Helwig et al teaches all of the claim limitations according to Claim 8. Both Milan and Helwig et al teach that the buffer specimen storage device and the outer transport device are arranged in a housing with a service opening ([0046] and Figure 2 respectively).

16. For Claim 10, Milan in combination with Helwig et al teaches all of the claim limitations according to Claim 9. Malin further teaches the climatic cabinet according to Claim 9, characterized in that it is designed as a separate unit that can be detachably connected to the climatic cabinet (Figure 5a Item Number 151).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bobby Ramdhanie, Ph.D. whose telephone number is 571-270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR


Jill Warden
Supervisory Patent Examiner
Technology Center 1700